

S/N: 10/672,867

Atty Dkt No. GP-302099/GM0406PUS

## REMARKS

The following remarks are intended to be fully responsive to the Office Action mailed April 26, 2004.

Claims 1-11 are pending. Claims 1-4, 6-8, 10, and 11 are rejected under 35 USC §102(b) as being anticipated by Pacella et al (6,328,359). Claims 5 and 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Pacella et al. Applicants have amended claims 1, 3, 6, 7, and 11. Applicants have cancelled claims 4, 5, 8, and 9.

### Claim Rejections – 35 U.S.C. § 102(b)

Claims 1-4, 6-8, 10, and 11 are rejected under 35 U.S.C. § 102(b) as being anticipated by Pacella et al. For a rejection to be proper under 35 U.S.C. § 102, every element and limitation found in the rejected claim must be found in the § 102 reference. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See MPEP §2131. Applicants have amended independent claims 1, 7, and 11 to recite elements and limitations that are not found, either expressly or inherently described, in Pacella et al.

Applicants have amended claim 1 to recite "a side impact member including an impact beam and a rub strip comprised of a material that is molded around at least a portion of the impact beam; the side impact member being connected to at least one of the inner panel and the outer panel such that the portion of the impact beam is outboard of the outer panel and the material separates the portion of the impact beam and the outer panel." (emphasis added).

Pacella et al do not teach or suggest a rub strip comprised of a material molded around a portion of the impact beam to separate the portion of the impact beam and the outer panel. Pacella et al merely teach the use of a "trim cap 72" to cover the outboard side of beam member 70. As shown in Figure 4a of Pacella et al, the trim cap

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72 does not separate any portion of beam member 70 and outer panel 42, as recited by claim 1.

It should be noted that amended claim 1 includes limitations similar to cancelled claim 5. With respect to cancelled claim 5, the Examiner admits that Pacella et al "do not disclose molding the rub strip to the impact beam." The Examiner further states that "It would have been obvious to one of ordinary skill in the art at the time the invention was made to mold the rub strip to the impact beam, of Pacella et al., to prevent accidental removal of the strip and decrease the number of steps to assemble the door." However, amended claim 1 does not recite that the rub strip is merely molded "to the impact beam," but rather amended claim 1 recite that the rub strip is "molded *around* at least a portion of the impact beam [and] the material separates the portion of the impact beam and the outer panel." Accordingly, Applicants respectfully submit that claim 1 is allowable. Claims 2-3 and 6 ultimately depend from claim 1 and are therefore allowable for at least the same reasons that claim 1 is allowable.

Moreover, claim 6 has been amended to recite that the "impact beam includes a first flange extending from the forward end of the impact beam and a second flange extending from the rearward end of the impact beam, the first flange being connected to the first wall and the second flange being connected to the second wall to transfer side impact loads from the impact beam to the first wall and the second wall and, correspondingly, to the hinge and the latch." The Examiner states that Pacella et al disclose that the "impact beam is attached to flanges (94, 96) that operatively connect the beam to the front wall and the rear wall." However, flanges 94, 96 of Pacella et al are not part of the beam member, but rather parts of the inner panel 40. In contrast, amended claim 6 recites that the "**side impact beam includes a first flange ... and a second flange.**" (emphasis added). This is a significant distinction because the impact beam of amended claim 6 has a direct connection to the forward and rearward walls; the beam member 70 of Pacella et al must be attached to the door frame structure 30 through fasteners extending through the outer panel 42.

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Similar to amended claim 1, claim 7 has been amended to recite "wherein the impact beam and rub strip material are matable to one of the inner panel and the outer panel such that the portion of the impact beam is outboard of the outer panel, the rub strip material separates the outer panel and the portion of the impact beam, and the rub strip material conceals the portion of the impact beam from view." Accordingly, the analysis presented for amended claim 1 also applies to amended claim 7. Applicants therefore submit that claim 7 is allowable. Claim 10 depends from claim 7 and is allowable for at least the same reasons that claim 7 is allowable.

Moreover, claim 10 recites that the "side impact member further comprises a first plate at a first end of the impact beam operatively connectable to the first wall to transfer impact loads to the hinge, and a second plate at a second end of the impact beam operatively connectable to the second wall to transfer impact loads to the latch." (emphasis added). As discussed above with respect to claim 6, the flanges 94, 96 of Pacella et al are part of the inner panel 40; flanges 94, 96 are **not** part of a side impact member including an impact beam matable to one of the inner panel and the outer panel as recited by claim 10.

Claim 11 has been amended to recite that "the rub strip is between at least a portion of the impact beam and the outer panel." As shown in Figure 4a of Pacella et al, no part of trim cap 72 is between the beam member 70 and the outer panel 42. Accordingly, Applicants respectfully submit that amended claim 11 is allowable.

### **CONCLUSION**

This Amendment is believed to be fully responsive to the Office Action mailed April 26, 2004. The remarks in support of the amended claims and the rejected claims are believed to place this application in condition for allowance, which action is respectfully requested.

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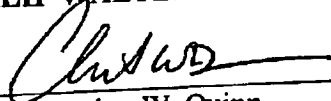
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Respectfully submitted

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